

In the Claims: (strikethrough parts deleted and underlined parts added)

Please delete Claims 10, 11 without prejudice or disclaimer.

9. (Currently Amended) A method of producing a custom insole for footwear, comprising the steps of:

- (a) taking measurements of a foot;
- (b) creating a foot profile based upon said measurements;
- (c) transferring said foot profile to a manufacturing station; and
- (d) producing said custom insole from said foot profile;

wherein said step (d) producing said custom insole is comprised of the following steps:

- I. generating a positive impression within a mold based upon said foot profile
- II. injecting a liquid resin into said mold formed upon said positive impression; and
- III. removing said custom insole after said liquid resin has hardened.

wherein said step a. generating a positive impression is comprised of the following steps:

- a. manipulating a plurality of pins beneath a membrane within a forming unit of said mold to reflect said positive impression; and
- b. resetting said plurality of pins after said step (III) is completed.

10. (Canceled)

11. (Canceled)

12. (Currently Amended) The method of producing said custom insole for footwear of Claim ~~11~~ 9, wherein step (c) transferring said foot profile utilizes a global computer network.

C. APPLICANT'S COMMENTS

Claims 9, 12 are pending in this Application, with Claim 9 being amended. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 9, 12 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 3 of the Official Action

The Official Action rejected as-filed Claim 9 under 35 U.S.C. §102(b) as being anticipated by White (U.S. Patent No. 5,237,520). The Applicant respectfully disagrees with this rejection particularly in view of the amendments made to the claims.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. But to be prior art under section 102(b), a reference must be enabling. . . . That is, it must put the claimed invention in the hand of one skilled in the art. . . . **The examiner bears the burden of presenting at least a prima facie case of anticipation.** In re Sun, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. ATD Corp. v. Lydall, Inc., 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998).

Under 35 U.S.C. §102, anticipation requires that **each and every element** of the claimed invention be disclosed in the prior art . . . In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. Akzo N.V. v. United States Int'l Trade Comm'n, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added). Anticipation requires the disclosure in a single prior art reference of

each element of the claim under consideration. W.L. Gore & Assocs. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984).

When more than one reference is required to establish unpatentability of the claimed invention anticipation under § 102 can not be found, and validity is determined in terms of § 103. Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746, 1748 (Fed. Cir. 1991).

Section 102(a) establishes that a person can not patent what was already known to others. If the invention was known to or used by others in this country before the date of the patentee's invention, the later inventor has not contributed to the store of knowledge, and has no entitlement to a patent. Accordingly, in order to invalidate a patent based on prior knowledge or use, that knowledge or use must have been available to the public. . . . Therefore, notwithstanding abandonment of the prior use -- which may preclude a challenge under § 102(g) -- prior knowledge or use by others may invalidate a patent under § 102(a) if the prior knowledge or use was accessible to the public. . . . Section 102(b), unlike § 102(a), is primarily concerned with the policy that encourages an inventor to enter the patent system promptly, while recognizing a one year period of public knowledge or use or commercial exploitation before the patent application must be filed. Thus an inventor's own prior commercial use, albeit kept secret, may constitute a public use or sale under § 102(b), barring him from obtaining a patent. . . . However, when an asserted prior use is not that of the applicant, § 102(b) is not a bar when that prior use or knowledge is not available to the public.

Woodland Trust v. Flowertree Nursery, Inc., 47 USPQ 2d 1363, 1365-66 (Fed. Cir. 1998).

Claim 9 has been amended to include the limitations of as-filed Claims 10, 11. The Applicant respectfully submits that White does not qualify as appropriate prior art under 35 U.S.C. §102(b) as White does not disclose all of the elements of the amended independent Claim 9.

Paragraphs 4-7 of the Official Action

The Official Action rejected Claims 10, 11, 12 under 35 U.S.C. §103(a) as being unpatentable over White in view of Dunham (U.S. Patent No. 3,696,456) and Gee (U.S. Patent No. 5,890,238). The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of *obviousness* based upon the prior art. In re Bell, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

"The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason."

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Independent Claim 9 has been amended to include the following limitations:

9. (Currently Amended) A method of producing a custom insole for footwear, comprising the steps of:

- (e) taking measurements of a foot;
- (f) creating a foot profile based upon said measurements;
- (g) transferring said foot profile to a manufacturing station; and
- (h) producing said custom insole from said foot profile;

wherein said step (d) producing said custom insole is comprised of the following steps:

- I. generating a positive impression within a mold based upon said foot profile
- II. injecting a liquid resin into said mold formed upon said positive impression; and
- III. removing said custom insole after said liquid resin has hardened.

wherein said step a. generating a positive impression is comprised of the following steps:

- c. manipulating a plurality of pins beneath a membrane within a forming unit of said mold to reflect said positive impression; and
- d. resetting said plurality of pins after said step (III) is completed.

With respect to Claim 10 (incorporated into Claim 9), the Official Action states that "Gee discloses the aspect of injecting a liquid resin which forms an inner sole portion upon a positive

impression.” Gee merely teaches filling a “cavity” with a “resilient foam material” (see Figures 1 and 2 of Gee). Gee does not teach the following significant steps contained within independent Claim 9:

- II. **injecting a liquid resin into said mold formed upon said positive impression;** and
- III. **removing said custom insole after said liquid resin has hardened.**

With respect to Claim 11 (incorporated into Claim 9), the Official Action states that “Dunham et al. teach[es] or suggest[s] the aspect of generating a positive foot impression by manipulating a series of probes or pins to reflect the positive impression and thereafter resetting the probes or pins.” Dunham merely teaches the usage of a plurality of “probes 31” that merely receive information about the shape of the side of the foot. Dunham does not use pins or probes to modify a mold, much less to manipulate a membrane. Dunham does not teach or suggest generating a positive impression is comprised of the following steps **(1) manipulating a plurality of pins beneath a membrane within a forming unit of said mold to reflect said positive impression, and (2) resetting said plurality of pins after said step (III) is completed.** This is a significant limitation of amended Claim 9 and is not present in any of the prior art references. Figures 6 and 7 of the present application disclose the method of manipulating the membrane with a plurality of pins.

For these reasons, among others, the combination of White with Dunham and Gee cannot suggest the combination of features in applicant’s Claims 9, 12, particularly as the same are now amended, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 9, 12 allowed.

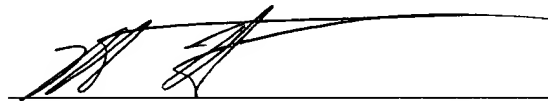
Paragraph 8 of the Official Action

The Applicant has amended Claim 9 to include the word “of” as suggested by the Examiner.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



Michael S. Neustel (Reg. No. 41,221)
NEUSTEL LAW OFFICES, Ltd.
2534 South University Drive, Suite No. 4
Fargo, North Dakota 58103

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Date

Telephone: (701) 281-8822
Facsimile: (701) 237-0544
e-mail: Michael@neustel.com




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Michael S. Neustel (Reg. No. 41,221)
NEUSTEL LAW OFFICES, Ltd.
2534 South University Drive, Suite No. 4
Fargo, North Dakota 58103

Telephone: (701) 281-8822
Facsimile: (701) 237-0544
e-mail: michael@neustel.com